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10/022,244	12/20/2001	Tadabumi Tomita	019519-342	7159

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10/15/2003

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,244

Applicant(s)

TOMITA ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment filed July 31, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

2. The copending application and the amendments filed therein has been received and reviewed.

***Response to Amendment***

3. The amendment filed July 31, 2003 has been entered and considered.
4. Claims 1, 3-11 are pending. Claim 2 was canceled.
5. The provisional double patenting rejection over copending Application No. 09/854,691 (US 2002/0094490), Endo et al. is withdrawn. The rejection under 35 USC 102 (e) over US Patent Application Publication No. 2002/0094490, Endo et al. is withdrawn.
6. The double patenting rejection over U.S. Patent No. 6,468,717, Kita et al. is withdrawn. The rejection under 35 USC 102 (e) over US 6,468,717, Kita et al. is withdrawn.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims <sup>1, 3-11</sup>~~1-11~~ are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant amended independent claim 1 to require the maximum inside diameter to be larger than the surface mouth diameter. Applicant pointed to page 14 as support for the amendment and in addition to the copending application (US 2002/0033108). In the current specification at page 14, it is noted that a sealing treatment is preferably performed on the surface mouth areas of the pores of the anodic film however there is no teaching in the current specification of requiring the mouth diameter to be smaller than the maximum inside diameter. It is possible to perform the sealing treatment on pores and lessen the average pore diameter when the pores have a mouth diameter of 30 nm and an inside diameter of 20 nm.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 4-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 09/730,842 (US 2001/0041305 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because in copending Application No. 09/730,842, Sawada et al. claim a planographic printing plate precursor comprising an aluminum substrate which has been subjected to a roughening treatment and an anodizing treatment which forms an anodized film on the surface of the substrate. The plate further comprises a photosensitive layer provided on the substrate, which contains an infrared absorbing agent and a water-insoluble and alkali aqueous solution soluble polymer compound (claim 1). The photosensitive layer comprising the infrared absorbing agent meets the present limitations for the image-forming layer containing a light-to-heat converting agent and the light-sensitive layer. Micropores present in the anodized film have a pore diameter of 1 to 5 nm and a pore density of  $8 \times 10^{15}$  to  $2 \times 10^{16}/\text{m}^2$  ( $8000/\mu\text{m}^2$  to  $2 \times 10^{11}/\mu\text{m}^2$ ) (claim 2). The anodized film layer meets the present limitations for the anodic oxide film layer wherein the micropores meet the present limitations for the pores of the present application. The copending Application does not claim the inside thickness or diameter of the micropores or the void ratio of the anodized layer however the pore density range of the present application falls within the pore density range of the prior art and the pore diameter

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range falls within surface mouth diameter range. Therefore the Examiner asserts one of ordinary skill in the art would expect other measurable characteristics of the anodized film layer of the prior art to at least overlap with those of the present application. It would have been obvious to one of ordinary skill in the art to make an infrared sensitive planographic printing plate precursor comprising an aluminum substrate, an anodized film comprising micropores having a surface mouth diameter of 1 to 5 and a pore density of  $8 \times 10^{15}$  to  $2 \times 10^{10}/\text{m}^2$  ( $8000/\mu\text{m}^2$  to  $2 \times 10^{-11}/\mu\text{m}^2$ ) and a photosensitive layer comprising an infrared absorbing agent and a water-insoluble and alkali aqueous solution soluble polymer compound based on the claims of Sawada et al.

b. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1, 3-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9 of copending Application No. 09/826,888 (US 2002/0039702 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because in copending Application No. 09/826,888, Hotta claims a planographic printing plate comprising an aluminum substrate comprising a roughened surface including an anodic oxide coating and a recording layer provided on the substrate. The anodic oxide coating can contain micropores exposed on the surface including diameters of not more than 15 nm (claim 1). The support can further comprise a sealing treatment applied on the anodic oxidation coating (claim 2). The recording layer can be a thermal type photosensitive layer directly writable by exposure to an infrared laser comprising infrared absorbing

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agent(s) (claims 6-9). The thermal photosensitive layer meets the present limitations for the image-recording layer and the light-sensitive layer. The anodic oxide coating meets the present limitations for the anodic oxide film layer. The copending Application does not claim the thickness of the micropores or the void ratio of the anodized layer however the micropores have diameters of not more than 15 nm and a density from 1000 kg/m<sup>3</sup> to 3200 kg/m<sup>3</sup>. The pore density is expressed differently in the prior art however it is clear the pore density of the prior art overlaps with the pore density range of 2,500/μm<sup>2</sup> or less of the present application. Therefore the Examiner asserts one of ordinary skill in the art would expect other measurable characteristics such as void ratio and the inside pore diameter or thickness of the anodized film layer of the prior art to at least overlap with those of the present application. It would have been obvious to one of ordinary skill in the art to make a planographic printing plate comprising an aluminum substrate comprising a roughened surface including an anodic oxide coating containing micropores and a thermal recording layer with reasonable expectation of obtaining a printing plate sensitive to infrared radiation based on the teachings of Hotta.

b. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Claims 1, ~~2~~-10 are rejected under 35 U.S.C. 102(e) as being anticipated by

Akiyama et al.

a. In US Patent Application Publication No. 2002/0033108, Akiyama et al. teach a heat sensitive lithographic printing plate precursor which comprises a substrate having thereon an anodic oxidation layer having uniformly distributed micropores of an average pore size of 6 to 40 nm and a hydrophilic layer containing at least one kind of particles (abstract & claims 1-13) having a size of 0.01 to 50  $\mu\text{m}$ , preferably 0.1 to 1.0  $\mu\text{m}$  (page 8, paragraphs [0097] & [0107]). A pore-sealing treatment can be applied after a pore widening treatment (page 4, paragraph [0047]). The anodic oxidation layer meets the present limitations for the anodic oxidation film layer. The precursor can form images by direct imagewise recording, e.g., with a thermal head, an infrared laser, etc. wherein solid-state high-output infrared ray lasers are preferred (page 17, paragraph [0175]). To the hydrophilic layer, a light-to-heat converting agent can be added for the purpose of enhancing the sensitivity. Such a light to heat converting agent by be any of light absorption materials having an absorption band in at least part of the wavelength range of 700 to 1,200 nm (page 11, paragraph [0149]). When the hydrophilic layer comprises the light-to heat converting agent, it meets the present limitations for the image-forming layer of the present application. The layer further meets the present



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limitations (of claim 8) for the particle layer because of the particles contained therein having a size of 0.01 to 50  $\mu\text{m}$  and the watersoluble overcoat layer containing a light-to-heat converting agent (claims 11-12) meets the present limitations for the image forming layer of present claim 8. Akiyama et al. does not teach the density of the micropores in the anodic oxidation layer however, the Examiner asserts one of ordinary skill in the art would expect the micropore density of the anodic oxidation film layer of Akiyama et al. to be within the required range of the present application because of overlap of the pore diameters. Further both the anodic oxide layers of the present application and of the prior art are subjected to a sealing treatment. The Examiner asserts one of ordinary skill in the art would expect the pores of the anodic oxide film layers to have similar void ratios and thickness.

14. Claims 1, 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawada et al.

a. In US Patent Application Publication No. 2001/0041305, Sawada et al. teach a planographic printing plate precursor comprising an aluminum substrate which has been subjected to a roughening treatment and an anodizing treatment which forms an anodized film on the surface of the substrate. The plate further comprises a photosensitive layer provided on the substrate, which contains an infrared absorbing agent and a water-insoluble and alkali aqueous solution soluble polymer compound (claim 1). Micropores present in the anodized film have a pore diameter of 1 to 5 and a pore density of  $8 \times 10^{15}$  to  $2 \times 10^{10}/\text{m}^2$  ( $8000/\mu\text{m}^2$  to  $2 \times 10^{-11}/\mu\text{m}^2$ ) (claim 2 & page 7,

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[0083]). Particularly a method in which anodizing is conducted under high current density in sulfuric acid electrolyte is preferable (page 6, paragraph [0071]). The anodized film layer meets the present limitations for the anodic oxide film layer wherein the micropores meet the present limitations for the pores of the present application. The copending Application does not teach the inside thickness or diameters of the micropores or the void ratio of the anodized layer however the pore density range of the present application falls within the pore density range of the prior art. One of ordinary skill in the art would expect other measurable characteristics of the anodized film layer of the prior art specifically the inside pore diameter to at least overlap with those of the present application. The photosensitive layer comprising the infrared absorbing agent meets the present limitations for the image-forming layer containing a light-to-heat converting agent and the light-sensitive layer.

15. Claims 1, 3-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Hotta.

a. In US Patent Application Publication No. 2002/0039702, Hotta teaches a planographic printing plate comprising an aluminum substrate comprising a roughened surface including an anodic oxide coating and a recording layer provided on the substrate. The anodic oxide coating can contain micropores exposed on the surface including diameters of not more than 15 nm (claim 1 & page 5, [0052]). The support can further comprise a sealing treatment applied on the anodic oxidation coating (claim 2 & page 4, [0047]-[0051]). The anodic oxide coating meets the present limitations for the anodic oxide film layer. The copending Application does not claim the inside thickness or diameter of the micropores or the void ratio of the anodized layer however the

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micropores have mouth diameters of not more than 15 nm and a density from 1000 kg/m<sup>3</sup> to 3200 kg/m<sup>3</sup>. The pore density is expressed differently in the prior art however it is clear the pore density of the prior art overlaps with the pore density range of 2,500/μm<sup>2</sup> or less of the present application. One of ordinary skill in the art would expect other measurable characteristics such as the inside diameter of the micropores and void ratio of the anodized film layer of the prior art to at least overlap with those of the present application. The recording layer can be a thermal type photosensitive layer directly writable by exposure to an infrared laser comprising infrared absorbing agent(s) (claims 6-9). The thermal photosensitive layer meets the present limitations for the image-recording layer.

### ***Response to Arguments***

16. Applicant's arguments filed July 31, 2003 have been fully considered but they are not persuasive.

a. As pointed out in the rejection under 35 USC 112, 1<sup>st</sup> paragraph there is insufficient support for the amendment to claim 1.

b. Additionally Applicant argued that it is evident from the disclosed treatment steps that the defined pore structure of the anodic oxide film is not inherent with the simple preparation and formation of a conventional anodic oxide film. The Examiner disagrees. In all of the rejections of record, the prior art's teachings overlap with at least one parameter with respect to the pores of the anodic oxide film layer. There is nothing in each of the respective applications and patents to suggest the maximum inside diameter of the pores is not inherently larger than the mouth diameter.

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***Allowable Subject Matter***

17. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter:

a. The hydrophilic layer of Akiyama et al. (in US Patent Application No. 2002/0033108) is not formed by electrolytic treatment of the aluminum support as required in the instant application. The particles are heat-fusible hydrophobic thermoplastic fine particles, finely divided polymers having thermally reactive functional groups and microcapsules in which compounds having heat-reactive functional groups are encapsulated (abstract).

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

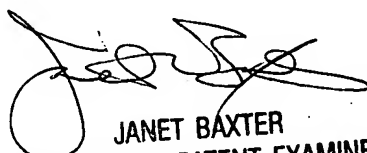
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Barbara Gilliam*

Barbara Gilliam  
Examiner, AU 1752  
October 14, 2003

  
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